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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,659	09/29/2003	Chun Te Yu	YUCH3041/JJC/JS	8271
23364 7590 12/08/2009 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314-1176				
EXAMINER				
GALL, LLOYD A				
ART UNIT		PAPER NUMBER		
3673				
MAIL DATE		DELIVERY MODE		
12/08/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/671,659

Applicant(s)

YU ET AL.

Examiner

Lloyd A. Gall

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2006 and 02 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

Claim 38 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,493,785 in view of Gambino. Claim 1 of the (785) patent teaches all of the limitations of claim 38 of the instant application, except for the first and second holes facing in the same direction. Gambino teaches first and second holes 4 facing in the same direction. It would have been obvious to modify claim 1 of the (785) patent to include first and second holes facing in the same direction, in view of the teaching of Gambino, to provide expected results.

Claims 38 and 40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 7,340,927 in view of Gambino. Claims 1 and 2 of the (927) patent teaches all of the limitations of claims 38 and 40 of the instant application, except for the first and second holes facing in the same direction. Gambino teaches first and second holes 4 facing in the same direction. It would have been obvious to modify claims 1 and 2 of the (927) patent to include first and second holes facing in the same direction, in view of the teaching of Gambino, to provide expected results.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 38 is rejected under 35 U.S.C. 102(b) as being anticipated by Gambino (978).

Gambino teaches a padlock having a longer arm 10, a shorter arm 11 rotatable about the longer arm, a confining block having a block portion (labeled “3”) on the right side of Fig. 2 which has a cylindrical portion extending below its block portion 3, the block portion is rotatably disposed outside of the lock body 1 as seen in Fig. 3, and the cylindrical portion of the block is disposed inside the lock body. When the block portion rotates between first and second positions, the shorter arm remains staying in a

receptacle 9 of the block in the Fig. 1 condition. The shorter arm of the shackle is outside of the lock body in the Fig. 2 condition, and holes 4 face in the same direction.

With respect to the following rejection, it is noted that the provisional application 60/443,331 upon which applicant is relying is not regarded as providing a clear support for a longer shackle leg and a shorter shackle leg.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loughlin (324) in view of Fleming et al (866). Loughlin teaches, and relying upon its provisional application 60/470,999, as seen in figs. 5a and 5b, a padlock having a lock body 12, a shackle longer arm 18, a shackle shorter arm 20 rotatable about the shackle longer arm, a block 32 including a rotatable engaging portion disposed outside the lock body and including a top receptacle and a gap 34. The bottom of the longer arm 18 is diagonally opposite the block 32. As disclosed in paragraph [0137], the block 32 is positioned above a key cylinder, and the block 32 is connected to the key cylinder with connecting elements (paragraph [0137], line 7). As seen in figs. 14-16, Fleming teaches a well known connection between a key cylinder 95 and an engaging portion 89, including a cylindrical portion 88 received within a lock body 84 and including a slot to receive a connecting element 87 of the key cylinder. It would have been obvious to provide a cylindrical portion below the block

portion 32 of Loughlin, in view of the teaching of Fleming et al, to connect to the key cylinder of Loughlin.

Claims 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loughlin in view of Fleming et al as applied to claim 38 above, and further in view of Lai (672).

Lai teaches a padlock combination lock including a shaft 34, inner sleeves 23 and digit wheels 24. It would have been obvious to modify the combination lock of Loughlin to include a shaft, inner sleeves and digit wheels, in view of the teaching of Lai, to provide expected results.

Applicant's arguments filed August 27, 2009 have been fully considered but they are not persuasive. In response to applicant's remarks in the sixth paragraph of page 4, it is respectfully submitted that the bottom flange on the tumbler ring 3 on the right side of fig. 2 defines a stem portion of the confining block 3. It is further submitted that the shorter arm of the shackle is outside of the lock body, in the fig. 2 condition. It is also submitted that at least a portion of the block portion 3 is outside of the lock body, as seen in fig. 3. In response to the arguments on page 5, the first full paragraph, it is noted that the shorter arm of the shackle is not claimed as being outside of the lock body, when in the lock condition.

In response to the remarks on page 6, the last two paragraphs, it is respectfully submitted that Fig. 7 of the provisional application, including the arrow shown on page 7 of the remarks, does not provide clear support for a longer leg of the shackle, and the above rejections using the Loughlin reference are repeated.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lloyd A. Gall whose telephone number is 571-272-7056. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lloyd A. Gall/
Primary Examiner, Art Unit 3673

/L. A. G./
Primary Examiner, Art Unit 3673
December 7, 2009